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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,264	03/07/2000	Michael C. Weaver	004528.P001	1291

500 7590 01/17/2003

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EXAMINER

CHEN, TE Y

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/520,264

Applicant(s)

WEAVER ET AL.

Examiner

Te Y Chen

Art Unit

2171

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: Please refer to Appendix.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-49.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


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APPENDIX

This is in response to amendment filed on 12/30/2002 (paper # 12).

Claims 1-49 remain rejected.

Information Disclosure Statement filed on 06/11/2002 has been considered, signed and dated as attached in the correspondence.

Regarding Applicants' arguments with respect to the rejection of claims 1-49, under the first paragraph of 35 USC § 112, the examiner disagrees with applicant's assertion that "the applicants have provided a description of subject matter in such a way to reasonable convey that the inventors had possession of the claimed invention."

Although Applicants interpreted the claims in light of the specification, limitations from the specification are not read into the claims. For example, at page 7, lines 11-19 of the present application described "electronic files" as "these legal documents can include e-mail documents, or any other type of electronic file or data that can be stored in a computer-readable storage media, and which can be subject to a legal proceeding or need to be otherwise/accessed," emphasis added. However, neither the claimed "electronic files" reflect the underlined features as cited in Applicants' specification, nor does the instant specification disclose the technique to integrate all of the possible tools or packages for storing and indexing the claimed electronic files. Thus, the specification

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is not adequate to reasonably convey that the inventors had possession of the claimed invention.

Furthermore, Applicants argue, “[a] person skilled in the art having read through the applicant’s disclosure and having knowledge of the relevant art will readily appreciate that the inventor had possession of the claimed invention” (Response filed 12/30/02, P4, Lines 2-5). The examiner points out that this is insufficient to satisfy the requirements under 35 USC § 112, *first paragraph*. The disclosure must also describe how to make and use the invention to one of ordinary skill in the art so that he need not perform undue experimentation.

Regarding Applicants’ arguments with respect to Beck’s Patent, Applicant’s arguments rehash issues already addressed on record (filed on 10/22/2002). For the purpose to help Applicant appreciate that the same feature claimed by Applicant is disclosed by Beck, please see Fig. 15, wherein, instead of direct interaction between each other, customer 305, is obviously communicates with Venders 1-3 (another type of customer of Beck’s system) via a third party (for example, Agents 1-3) using the agent collaboration module as disclosed in the same Figure by Beck.